

PATENT
Attorney Docket No. EX03-059C-PC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of: TAI ET AL.

Serial No.: 10/523,706

Filed: 08/06/2003

For: PSMCs as Modifiers of the RB
Pathway and Methods of Use

Confirmation No. 9877

Group Art Unit: to be assigned

Examiner: to be assigned

RENEWED SUBMISSION UNDER 37 C.F.R. § 1.497(d)

RESPONSE TO DECISION OF A REQUEST
TO CORRECT INVENTORSHIP UNDER 37 C.F.R. § 1.497(d)

Assistant Commissioner for Patents
Mail Stop PCT
Alexandria, VA 22313-1450

ATTN: PCT Legal Office

Sir:

RECEIVED

8 AUG 2006

Legal Staff
International Division

Responsive to the Decision of a Request to Correct Inventorship under 37 C.F.R. § 1.497(d) dated June 14, 2006, Applicants respectfully request reconsideration in view of the following remarks. A two month response time was set. Thus this document is considered timely filed if filed on or before August 14, 2006.

The U.S.P.T.O.'s Decision to Dismiss Applicants' Request to Correct Inventorship under 37 CFR § 1.497(d), mailed June 14, 2006, alleges that counsel has not provided copies of the complete declaration documents signed by each inventor.

Applicants respectfully submit that the declaration filed on March 21, 2005, complies with the requirements of 37 C.F.R. § 1.497(a), 37 C.F.R. § 1.66 and 37 C.F.R. § 1.68. It is the routine business practice of Exelixis, Inc., to provide each named inventor

of a utility or design patent application with a complete copy of a declaration naming all of the inventors under 37 C.F.R. § 1.66. Based on the normal business practice of Exelixis, Inc., each named inventor in the above-referenced application reviewed all the of pages of the declaration listing each named inventor, as filed on March 21, prior to signing it. There is no requirement to submit to the U.S.P.T.O. all of the duplicative pages from every declaration sent to all of the inventors.

The Examiner also alleges that the "Consent of the Assignee" requirement under 37 CFR 1.497 § (d) has not been complied with. The Examiner alleges that Applicants have not requested that an Assignment be recorded nor indicated where the reel and frame number were recorded. Applicants respectfully submit that the Assignment for this Application was recorded on 3/17/05 in reel/frame 015914/0219. Accordingly, the "Consent of the Assignee" requirement under 37 CFR 1.497 § (d) has been complied with.

Accordingly, Applicants' declaration filed on March 21, 2005, complies with the requirements of 37 C.F.R. § 1.497(a), 37 C.F.R. § 1.66 and 37 C.F.R. § 1.68. Applicants respectfully request reconsideration and withdrawal of the U.S.P.T.O.'s Decision to Dismiss Applicants' Request to Correct Inventorship under 37 CFR 1.497 § (d).

The Examiner is invited to call the undersigned attorney if there are any outstanding issues to be resolved regarding the above-identified patent application.

It is believed that no fee is due in connection with this paper; however, if a further fee is due, please charge our Deposit Account No. 50-1108.

Respectfully submitted,
EXELIXIS, INC.

Date: August 8, 2006

By: Robert L. Bernstein
Robert L. Bernstein
Registration No. 46,020

EXELIXIS, INC.
170 Harbor Way, P.O. Box 511
South San Francisco, California 94083-0511
Telephone: (650) 837-8223
Facsimile: (650) 837-8234